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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/396,531
Filing Date: September 15, 1999
Appellant(s): ADDINGTON ET AL.

Joel Rosenblatt
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 6/22/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is substantially correct. The invention is a finger cot designed to be worn over the finger for protection and grip while a person is bowling. Rudimentary to all finger cots is the placement of the cot in contact with the finger of the user and to distribute "forces" applied to the finger to prevent injury such as impact, cutting or abrasions. When a bowler throws a bowling ball, the ball is swung forward with the thumb first at a "12 o'clock position (for a right handed bowler). During the upswing the thumb has a natural tendency to rotate to about the 9 o'clock position placing a rotation on the ball. When this tendency to rotate is further increased by a bowler this is referred to as "lift" on the ball. This style of bowling is done in order to place spin on the ball so that a hooking action occurs as it rolls down the alley which has been shown to cause greater "pin action" and presumed higher scoring. Any force by the bowler on the ball to control its motion forward and rotate it with his fingers during the delivery creates obvious opposing forces between the ball and the fingers. Where grip is important bowlers have been known to wear finger cots to improve the grip so that greater forces can be handle without the fingers slipping from the ball. In other situations, the forces cause rubbing between the ball and the fingers or even a pulling action on the knuckles as the ball is released. Bowlers have used many types of protection apparatus for the fingers to protect them from the forces encountered in bowling. This invention is a finger protector intended to be used while a person bowls to protect the fingers from soreness or injury.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-17, 19-32; 1-15, 16, 17, 19, 31 and 32; and 15, 17, 19, 20, 22 and 23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

617,929	Fowble	1-1899
5,881,388	Pratt	3-1999
3,046,561	Marinese et al.	7-1962

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

I. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims should be amended to remove positive recitations to "the bowling ball" (note claim 1, paragraph c) so as not to imply that the bowling ball is being claimed in combination with the finger shield. Likewise, the scope of claims new claims 16 and 19 are unclear in that one cannot determine if the bowling ball is being claimed in combination with the finger pad shield. While the ball is functionally recited in the preamble, it is positively referred to in the body of the claim. The preamble and the body of the claim must be in harmony. Further, the claim positively recites "the bowler" and "said bowler's finger" implying that such is also being claimed in combination which is improper. Claims 17 and 20 is indefinite since one cannot determine what the range may be. A child is not as strong as an adult. Further the lift produced and the force developed on the finger depends on the technique and method used by a person. Each is individual and techniques would tend to produce a greater "maximum force" than others. For example, the point if the point of release of the ball by a bowler in the arch of the swing of the arm is low the force would be low and if the release point is high the forces due to lift would also be high. The english used in claim 18 is disjointed and one cannot determine the scope of the structure intended to be further limited. Claims 25 and 26 contradict claim 24 such that one cannot determine the scope of the claim.

II. Claims 15, 17-20, 22 and 23 are further objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

III. Claims 1-5, 9-23 and 27-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Fowble.

Note marked examiner's marked copy of Fowble included with this action. As to claims 1, 3, 15-23 and 27-31, Fowble shows a finger pad A, having a pad shield means with a first curved surface 1 and a second surface 2 including a contact area at 3. The recitations in paragraph c. are functional and fail to distinguish over Fowble.

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Further shown by him is a "means for placing" by slipping the finger into the shield and the shield is made of rigid material. As to claim 2, he further shows two side walls terminating in an end at c. The shield is open at c as called by claim 4. At the reference marked 4, he shows a closed end called for by claim 5. As to claims 9, 11 and 27, strap 5 is capable of functioning as a "limit means" and is considered a "raised surface" as called for in claim 10. Reference 6 is considered a "support means" as called for by claim 12-14.

IV. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

V. Claims 6-8 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fowble in view of Pratt.

As to claim 6, Pratt shows combining finger inserts with gloves in order to position them on the hand. To have included a glove in combination with the insert shown by Fowble would have been obvious in order to keep hold the insert and to further protect the rest of the hand.

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VI. Claims 16-21, 27-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marinese et al.

Claims 16, 19, 31 and 32 are clearly shown. Marinese is inherently capable of from the maximum force developed by a bowler as called for in claims 17, 18 and 20. Marinese is rigid as called for in claim 21. As to claim 27, wall part 3 extends obliquely (col. 2, ln. 66) to limit the depth of insertion of said finger pad shield in the finger hole. Wall part 3 is considered to be a "raised surface as called for in claim 28. Element 7 is considered a support as called for in claim 29. As to claim 30, both the shield and the support can be made from a polymer material.

VII. Claim 24-26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marinese in view of Pratt.

Pratt shows combining finger inserts with gloves in order to position them on the hand. To have included a glove in combination with the insert shown by Marinese would have been obvious in order to keep hold the insert and to further protect the rest of the hand.

(11) Response to Argument

VIII

As stated in the final office action in response to applicant's remarks, Appellant's remarks with respect to the Administrative Procedure Act are inappropriate. The basic purposes of the Administrative Procedure Act may be said to have four basic purposes as follows: 1.To require agencies to keep the public currently informed of their organization, procedures and rules (sec.3.) 2.To provide for public participation in the rule making process (see. 4). 3.To prescribe uniform standards for the conduct of formal rule making (sec. 4(b) and adjudicatory proceedings (sec. 5), i.e., proceedings which are required by statute to be made on the record after opportunity for an agency hearing (secs. 7 and 8). 4.To restate the law of judicial review (see. 10). Such has nothing to do with the examination of patents and applicant should not cloud the prosecution by referring to it. Applicant, as a patent professional, should be aware by now that the examination of patents is conducted in accordance with the Manual of Patent Examining

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Procedure. The examination of applications is covered in chapter 700. Hence, all of applicant's remarks will be responded to in accordance with the MPEP and not the APA.

Applicant should note that The legislative history of the APA suggested to the Federal Circuit that "Congress drafted the APA to apply to agencies generally, but that because of existing common law standards and the availability of trial de novo pursuant to §4915 of the Revised Statutes, the predecessor of 35 USC §145, Congress did not intend the APA to alter the review of substantive Patent Office decisions.". See 5 USC §559 (emphasis added).

As a result, the Federal Circuit concluded: From this background, we construe §559 as freeing Patent and Trademark Office patentability decisions from judicial review under standards enumerated by §§706(2)(A) (arbitrary or capricious standard applied to informal agency proceedings) and 706(2)(E) (substantial evidence standard applied to formal agency proceeding), to the extent that a statutory or common law standard was a more searching standard and hence an additional requirement recognized prior to 1947 that has not since been statutorily modified. Thus, the portion of §§559 stating that the judicial review provisions of the Act were not meant to "limit or repeal additional requirements ... recognized by law" is best understood as preserving those standards of judicial review that had evolved as a matter of common law, rather than compelling that all such standards of review be displaced by the new statute. This construction preserves the benefits derived from the symbiotic relationship between judicially constructed common law and congressionally fashioned statutory law in the area of judicial review.

As to *Dickenson v. Zurko*, the case has done nothing to change the way patents are examined as set forth in the Manual for Patent Examining Procedure. The case deals only with limiting the power of the U.S. Court of Appeals for the Federal Circuit (CAFC) to "second guess" the USPTO in making patentability judgments, including those concerning obviousness. The *Zurko* decision involved a disputed non-obviousness decision by the CAFC and as a result of the decision in the case, in the future, the CAFC will be unable to substitute its judgment for that of the USPTO unless the CAFC determines that the USPTO abused its discretion or acted arbitrarily or capriciously in reaching its conclusion of unpatentability.

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Appellant's continued reference to the APA and the "lawfulness" of the examiner's grounds for rejection only serve to cloud the issues. As such, applicant's references thereto will not be further addressed.

I. (Argument No. 1)

A.

Appellant's point is not clear and examiner will not guess to comment thereon.

B.

Appellant takes the position that the claims "do not" positively recite "the bowler" finger", "the bowler" or "the bowling ball". However, the rejection is not that such is being done. The rejection is that it is not clear if such is being done. Instances where one cannot determine what is being claimed in combination must be evaluated on an individual basis. In the instant case, it is the preamble sets forth that the invention is a "finger pad shield" and recites function pertaining to the bowler and the bowling ball. One would expect that the bowler and the ball are not being claimed in combination. Yet, the body of the claim positively refers to "the bowler" and "said bowling" ball which forces one to question the scope of the claim. In questioning the scope of the claim one must also have to look at the "means plus function" language where the bowling ball is positively recited. From this language it appears that applicant is limiting the field of use to the combination of a bowling ball since the shield and its structure is being recited as dependant upon the forces imposed by a bowling ball. Without the combination of the bowling ball one could not determine any metes and bounds to the claims since one could not have be "receiving a force of said bowling ball" (claim 1, para. c). Further, applicant argues that the force of the bowling ball is critical and that the prior art is not analogous since it is not used in bowling. As such, from the body of the claims and the arguments presented by applicant in his remarks, it would appear the bowling ball is being claimed in combination. It is this contradiction between the preamble, which appears only to recite a subcombination, and the body which appears to recite the combination that renders the scope of the claim unclear.

Bowling ball

Applicant's position in this section is unclear. The examiner has not "rejected the preamble" as "having positive recitations to the bowling ball" or for the use of functional language. The examiner has rejected the claims as

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being unclear in scope if the bowling ball is being claimed in combination. The examiner has even suggested how to amend the claim in his final office action by stating that, "claims should be amended to remove positive recitations to "the bowling ball" (note claim 1, paragraph c) so as not to imply that the bowling ball is being claimed in combination with the finger shield." To this comment applicant has done nothing to simply amend the claims to insert language such as "adapted to..." or "a bowling ball". Examiner cannot determine whether appellant is just being argumentative or if he just not in a capacity to understand. At the middle of pg. 6 of his Brief he makes the assertion that, "it is clear to one skilled in the art in view of the content of the application and the teachings of the prior art...the claimed invention does not claim the combination". As set forth above by the examiner, it is not so clear to one skilled in the art since the entire application, claims and arguments made by the applicant all require the "bowling ball". The situation must be clear for the purposes of infringement to what the claims exclude. Applicant argues throughout the record that other finger cots are not analogous since they are not "used in bowling" and do not "require a bowling ball". Hence taken as a whole, the scope of the claim is not clear to one skilled in the art.

Applicant's discussion of other patent at the bottom of pg. 6 is inappropriate since their prosecution and merits are a separate set of circumstances and facts that have no influence in how the instant set of circumstances and facts are to be determined. As such no further comment is deemed necessary.

Appellant's comments that the examiner has not complied with the APA as a result of his inability to understand the rejection is considered moot

C.

As to claims 16 and 17, the MPEP is clear that one must be able to determine the meets and bounds of the claim. To do such one needs to consider what the MPEP states with respect to such functional language. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does ." (emphasis in original) Hewlett - Packard Co . v. Bausch & Lomb Inc ., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Set forth in this section is that a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. Applicant's position that "a maximum natural force limited by a limit of muscular skeletal development" is

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clear to one skilled in the art. The examiner, being one skilled in the art, does not have a clue what it means. Such a term of degree set forth in functional must set forth "definite boundaries on the patent protection sought". In re Barr, 444 F.2d 588, 170 USPQ 33 (CCPA 1971). Here, first off one is not clear what is a "maximum natural force" and the "limit o muscular skeletal development" is different for all bowlers based on age, size, ability and style of delivery. Hence under such variable conditions, there exists no way for one skilled in the art to determine "definite boundaries".

MPEP 2173 states that the "definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art..." In the instant case the prior art recognizes the many variables that make up the forces between a bowler's fingers and the bowling ball. Further, MPEP 2173.05(b) (Relative Terminology) discusses the situation at hand. WHEN A TERM OF DEGREE IS PRESENT, (examiner must) DETERMINE WHETHER A STANDARD IS DISCLOSED OR WHETHER ONE OF ORDINARY SKILL IN THE ART WOULD BE APPRISED OF THE SCOPE OF THE CLAIM. When a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification. While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph is proper. See In re Wiggins, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973). Further stated is that REFERENCE TO AN OBJECT THAT IS VARIABLE MAY RENDER A CLAIM INDEFINITE. A claim may be rendered indefinite by reference to an object that is variable. For example, the Board has held that a limitation in a claim to a bicycle that recited "said front and rear wheels so spaced as to give a wheelbase that is between 58 percent and 75 percent of the height of the rider that the bicycle was designed for" was indefinite because the relationship of parts was not based on any known standard for sizing a bicycle to a rider, but on a rider of unspecified build. Ex parte Brummer, 12 USPQ2d 1653 (Bd.

Pat. App. & Inter. 1989). In the instant case, the specification does not set forth any standard to which one can measure the scope of the claim and one skilled in the are could not know the scope to the claim. While appellant presents the position that such language in the claims "provides a standard" (pg. 9, ln. 1) by referring to the declaration of Dr. Addington (paper No. 7) the examiner cannot agree since such amounts to a general allegation that the language would be clear to one skilled in the art without offering any evidence to support it.

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Appellant's remarks with respect to the issued Patent is immaterial and will not be discussed to cloud the issues.

D.

Applicant argues in favor of claims 26 that the "Examiner's reasonably proper action should have been merely to suggest removing the repetitive recitation". With that understanding, it is submitted that appellant admits that there exists a problem with the claims but instead of amending to correct the problem, he instead chooses to criticize the examiner for being brief. Since the claims stand unchanged with no convincing argument the this grounds for rejections should be sustained.

E.

The finality of an office action is a petitionable issue and not one for appeal. As such this section is rendered moot and no further consideration by the Board is deemed necessary.

F.

For the reasons stated in response to appellant's arguments in section C., the language of claim 15 also fails to set forth a definite standard where one skilled in the art can determine what material is rigid enough to be "adapted to spread said force of said bowling ball over said contact area". In a broadest sense, any material even a soft semi-rigid material will do that. Albeit, the force may not be spread evenly over the contact area. As set forth above, there is no definite standard by which one skilled in the are can determine "how rigid" the material should be. Likewise, any material may "resist deformation". It appears from appellant's remarks that he intends for the scope of such language to be interpreted the same as "preventing deformation". However, such is not the case since the examiner has given the language it broadest reasonable interpretation.

Appellant's point to the analysis of the term narrative is unclear. The MPEP is clear that the claims must positively recite what the applicant's invention. Reciting how the invention is intended to perform when subjected to undefined conditions does not set forth a clear scope of the claim.

With respect to claim 15, examiners conclusion is based on the MPEP 2173 and 2173.02 such that the scope of the claim is not clear to inform the public of the boundaries of hat constitutes infringement of the patent. While it is true that a claim may be written as a means plus function under 122, 6th paragraph, that does not mean that the scope of the claim can be indefinite. First claim 15 recites that the shield means is "made to substantially resist deformation".

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How one makes something to "resist deformation is vague and indefinite. One cannot even determine if the device deforms under a force or not. Further example of the problem with the claim is that it cannot be determined if it is the material or the structure of the device that allows it to resist deformation. Two of a same device, one made of foam rubber and the other of steel, can both be said to "substantially resist deformation". While applicant considers examiners statement "vague and ambiguous", examiner has assumed applicant's representative had a basic understanding for the requirements of 112, second paragraph as outlined in the MPEP. However, it is apparent that the applicant is confused by his own self developed "APA standard" the patent prosecution.

To say that claim 15 is written as a "means plus function" is in error since no clear statement of function exists. The claim is narrative and only recites that the shield is "made to" resist deformation. The claim must positively recite the structure as required under 112, 2nd paragraph. Lastly, "the fact that a particular mechanism . . . is defined in functional terms is not sufficient to convert a claim element containing that term into a 'means for performing a specified function' within the meaning of section 112(6)." Greenberg, 91 F.3d at 1583, 39 USPQ2d at 1786 ("detent mechanism" defined in functional terms was not intended to invoke 35 U.S.C. 112, sixth paragraph).

Claim 15 is not a means plus function claim as referred to in 35 U.S.C. 112, sixth paragraph. Claim 15 is a narrative recitation of making the device for an intended use (i.e. "made to substantially resist deformation") While applicant continues his remarks by discussing the description of the "maximum force" in the specification and continues to assert that the claim is a means plus function as allowed in 112 6th paragraph examiner cannot agree. He wrongly states as a result of this description, "the functional limitation expressed in Claim 15 is on a "finger pad shield means," "adapted to spread said force of said bowling ball..." However, 35 U.S.C. 112, sixth paragraph states that an "element in a claim" may be expressed in means plus function. The function of spreading the force is merely narrative and descriptive of the whole finger shield device and does nothing to render the claim definite or permissible under 112, 6th paragraph. In short, merely stating what "something does" does is not definite if no clear structure can be determined.

Applicant's subsequent reference to the APA and other US patent again will not be addressed as not being pertinent.

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II (Argument No. 2)

A dependent claim must further positively recite structure that further limits the claimed invention. Claims 15, 17-20, 22 and 23 fail to recite any positive structure and merely offer to discuss how the apparatus will perform in an undefined environment. As such the claims fail to conform to the requirements of 112, 2nd paragraph and the rejection should be sustained. Appellant has offered reprinting of the claims with a mere allegation that they are proper. As such, there exists no basis to reverse this grounds of rejection.

III. (Argument No. 3)

A.

Appellant's point is unclear and no further comment is considered appropriate.

B.

As to Fowble, claim 1 is not a "means plus function claim" as applicant states at the top of his pg. 15. The 112, 6th paragraph allows for "an element" in a claim to be recited as a means plus function. However, this argument is moot since Fowble is applied under 102 and the MPEP states that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). While it is clear that intended use recitations and other types of functional language cannot be entirely disregarded. In an apparatus such as a finger shield, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As state in the previous office action, the functional statements of paragraph c. fail to distinguish over the art since the applied art is capable of performing the intended use of protecting the finger while bowling and spreading out the force applied by the finger to the bowling ball.

Applicant's continued reference to the function of his finger shield as spreading the force does nothing to distinguish over the art of "finger protectors" in general. Supporting and spreading the force to protect a finger is

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rudimentary to their purpose. Note that merely claiming a property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

See also MPEP § 2112.01 with regard to inherency.

Applicant continues to state that examiners statement that "the recitations in paragraph c. are functional and fail to distinguish over Fowble" is improper. However, applicant chooses to ignore the MPEP and again offer clouded arguments pertaining to an APA Standard he has devised. Note MPEP 2114 pertaining to apparatus and article claims and functional language used therein (for a discussion of case law which provides guidance in interpreting the functional portion of means - plus - function limitations see MPEP § 2181 - § 2186). It is held that apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danley, 120 USPQ 528, 531 (CCPA 1959). "Apparatus claims cover what a device is, not what a device does." (emphasis in original) Hewlett - Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Further the manner of operating the device does not differentiate the apparatus from the prior art. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was "for mixing flowing developer material" and the body of the claim recited "means for mixing..., said mixing means being stationary and completely submerged in the developer material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

Further applicant insists on referring to the function of applying force to a bowling ball. The mere intent of using his finger device on a bowling ball does not distinguish it over the art of record. MPEP 2115 discusses the material or article worked upon by apparatus. "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164

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USPQ 666, 667 (Bd. App. 1969). Furthermore, "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." In re Young , 25 USPQ 69 (CCPA 1935) (as restated in In re Otto , 136 USPQ 458, 459 (CCPA 1963).

In re Casey , 152 USPQ 235 (CCPA 1967), an apparatus claim recited "A taping machine comprising a supporting structure, a brush attached to said supporting structure, said brush being formed with projecting bristles which terminate in free ends to collectively define a surface to which adhesive tape will detachably adhere, and means for providing relative motion between said brush and said supporting structure while said adhesive tape is adhered to said surface." An obviousness rejection was made over a reference to Kienzle which taught a machine for perforating sheets. The court upheld the rejection stating that "the references in claim 1 to adhesive tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.").

Further a mere recitation of what something "does" is not sufficient to distinguish the device from the prior art if the prior art is capable of performing that function. The distribution of forces over a larger area is rudimentary to finger protectors in general. This protects the finger from injury when a force is continually applied to a single small area of the finger to cause a bruise or blister or to spread the force along the finger to give the finger support.

As stated above, the intended use of applicant's invention to pick up bowling balls does not distinguish it from Fowble since intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault , 164 USPQ 666, 667 (Bd. App. 1969).

Appellant argues that the examiner must "show in a single reference every element of the claim" than discusses how to bowl and gives a physics lesson on Newton's Law. His position appears to be one of analogous art and that since Fowble is not disclosed as being used with a bowling ball, then it cannot meet the functional limitations. The first position is that intended use carries little weight. Held is that if a piece of prior art meets the structure then the burden is on the applicant to show that it is not capable of performing the functions recited. This doctrine or inherency is surely well understood by the Board and is well defined in the MPEP so it will not be

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reiterated. Even when cloaked within a means plus function language, nothing prevents the prior art from being used with a bowling ball. One concerned with the forces of a ball injuring the hand would surely consider how hands are protected in various other endeavors. Clearly the finger cot of Flowble performs the function "to spread" force "over said contact area of said first surface for reducing the pressure over said contact area" (as required by claim 1 omitting the intended use of the bowling ball). Such a protection from the forces encountered in performing a task is rudimentary to finger protecting cots.

IV. (Argument No. 4)

Appellant argues the combination of Flowble and Pratt as being improper because neither relates to bowling. This position is not persuasive for the reasons set forth above in that such are analogous art to one wishing to protect fingers in general. The fact that these references are used to protect the fingers while performing different tasks (intended functions) is irrelevant. As such, a prima facie case is clearly shown and the board is asked to sustain the rejection.

V. (Argument No. 5)

Appellant's remarks with respect to Marinese are noted by the examiner. The examiner's opposed position is clearly set forth in the grounds for rejection above and will not be reiterated here. Hence in view of the examiner's broadest reasonable interpretation of the language used in the claims and under the principles of inherency, the Board is asked to sustain this rejection.

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VI. (Argument No. 6)

Appellant sets forth previously used arguments of intended use. For the examiner's reasons set forth above, the prior art is clearly analogous to the problem at hand and inherently is capable of performing all the functional in intended use limitations recited in the claims. Appellant has nothing of record to meet his burden of showing that the prior art is not capable of performing in use with a bowling ball.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

October 21, 2001

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